

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION

CONVOLVE, INC.

Plaintiff,

v.

DELL INC.,  
WESTERN DIGITAL CORPORATION,  
HITACHI GLOBAL STORAGE  
TECHNOLOGIES, INC., and  
HITACHI LTD.

Defendants.

Civil Action No. 2:08-cv-244

**CONVOLVE, INC.'S ANSWER AND AFFIRMATIVE DEFENSES TO WESTERN  
DIGITAL CORPORATION'S COUNTERCLAIMS**

Plaintiff Convolve, Inc. ("Convolve") by and through its undersigned counsel, hereby responds to Defendant, Western Digital Corporation's ("Defendant"), Counterclaims and asserts its affirmative defenses thereto as follows:

**COUNTERCLAIMS**

1. Counter-Plaintiff Western Digital Corporation is a Delaware corporation, with its principal place of business in Lake Forest, California.

**ANSWER:** On information and belief, admitted.

2. On information and belief, Counter-Defendant Convolve is a New York corporation, with its principal place of business in Armonk, New York.

**ANSWER:** Admitted.

3. These are counterclaims for a declaratory judgment of noninfringement and invalidity that arise under the Declaratory Judgment Act, specifically, 28 U.S.C. §§ 2201 and 2202, and the

Patent Act, 35 U.S.C. § 100, et seq. Jurisdiction in this Court is proper pursuant to 28 U.S.C. § 2201(a).

**ANSWER:** Convolve admits only that jurisdiction in this Court is proper. Convolve denies any remaining allegation of paragraph 3.

4. Counter-Defendant has chosen this venue to enforce its patents. Venue is proper in this Court and judicial district for counterclaims pursuant to 28 U.S.C. §§ 1391 and 1400(b).

**ANSWER:** Admitted.

#### **FIRST COUNTERCLAIM**

##### **NONINFRINGEMENT OF THE '473 PATENT**

Convolve makes no averment or admission concerning the preceding heading and therefore denies any factual assertion allegedly contained therein.

5. Western Digital realleges and incorporates herein by reference Paragraphs 1-4 of its Counterclaims, above.

**ANSWER:** Convolve incorporates its responses to Paragraphs 1-4 of Defendant's Counterclaims as though stated herein in their entirety.

6. Convolve has made allegations that Western Digital infringes the '473 patent through the manufacture, use, sale, offer for sale, or importation of certain products of Western Digital.

**ANSWER:** Admitted.

7. Convolve's actions and allegations have created a case or controversy between Counter-Plaintiff and Counter-Defendant.

**ANSWER:** Convolve admits that Defendant alleges that Defendant does not infringe any valid and enforceable claim of the '473 Patent. Convolve asserts that Defendant has infringed the '473 Patent, and that the '473 Patent is valid and enforceable against Defendant. Thus, Convolve admits that an actual and justiciable controversy exists between the parties. Any remaining allegation of Paragraph 7 is denied.

8. Products made, used, sold, offered for sale, or imported by Western Digital lack at least one requirement of the inventions claimed in the '473 Patent.

**ANSWER:** Denied.

9. Western Digital is entitled to a declaratory judgment pursuant to 28 U.S.C. § 2201 that its accused products do not infringe the '473 Patent.

**ANSWER:** Denied.

## SECOND COUNTERCLAIM

### INVALIDITY OF THE '473 PATENT

Convolve makes no averment or admission concerning the preceding heading and therefore denies any factual assertion allegedly contained therein.

10. Western Digital realleges and incorporates herein by reference Paragraphs 1-9 of its Counterclaims above.

**ANSWER:** Convolve incorporates its responses to Paragraphs 1-9 of Defendant's Counterclaims as though stated herein in their entirety.

11. Claims of the '473 patent are invalid, *inter alia*, for at least one of the following reasons: they are anticipated under 35 U.S.C. § 102; they are obvious under 35 U.S.C. § 103; the specification does not comply with 35 U.S.C. § 112, first paragraph; and the claims do not comply with 35 U.S.C. § 112, second paragraph.

**ANSWER:** Denied. The '473 Patent is valid and enforceable. All claims of the '473 Patent are presumed valid and enforceable in accordance with 35 U.S.C. § 282, and the Defendant has the burden of proving by clear and convincing evidence that any claim of the '473 Patent is invalid and/or unenforceable.

12. Western Digital is entitled to a declaratory judgment pursuant to 28 U.S.C. § 2201 that claims of the '473 are invalid.

**ANSWER:** Denied. The '473 Patent is valid and enforceable. All claims of the '473 Patent are presumed valid and enforceable in accordance with 35 U.S.C. § 282, and the Defendant has the burden of proving by clear and convincing evidence that any claim of the '473 Patent is invalid and/or unenforceable.

13. Western Digital demands a jury trial as to all elements so triable.

**ANSWER:** Convoke admits that Defendant demands a jury trial. Convoke denies any remaining allegation of Paragraph 13.

**PRAYER FOR RELIEF**

Wherefore, Western Digital respectfully prays that:

a. The Second Amended Complaint be dismissed with prejudice;

**ANSWER:** Convoke denies that Defendant is entitled to this relief or any other relief.

b. The Court enter judgment in favor of Western Digital

**ANSWER:** Convoke denies that Defendant is entitled to this relief or any other relief.

c. The Court deny all relief sought by Convoke;

**ANSWER:** Convoke denies that Defendant is entitled to this relief or any other relief.

d. The Court adjudge, declare, and decree that all of the claims of the '473 patent are invalid, and that all of the claims of the '473 patent have not been infringed by Western Digital;

**ANSWER:** Convoke denies that Defendant is entitled to this relief or any other relief.

e. The Court issue a judgment declaring this case to be exceptional in favor of Western Digital under 35 U.S.C. § 285, and award to Western Digital its reasonable attorney's fees and other expenses incurred in connection with this action;

**ANSWER:** Convoke denies that Defendant is entitled to this relief or any other relief.

f. The Court issue judgment awarding Western Digital its costs of suit incurred in this action; and

**ANSWER:** Convoke denies that Defendant is entitled to this relief or any other relief.

g. The Court grant Western Digital such other further relief to which it may be entitled.

**ANSWER:** Convolv denies that Defendant is entitled to this relief or any other relief.

### **GENERAL DENIAL**

Any allegation set forth in Defendant's Counterclaims not expressly admitted is hereby denied.

### **AFFIRMATIVE DEFENSES**

Pursuant to Federal Rule of Civil Procedure 8(c), Convolv asserts the following affirmative defenses to Defendant's Counterclaims:

#### **First Affirmative Defense**

Defendant's Counterclaims, in whole or in part, fail to state a claim upon which relief can be granted.

#### **Second Affirmative Defense**

Defendant has infringed one or more claims of the '473 Patent.

#### **Third Affirmative Defense**

No claim of the '473 Patents is invalid.

#### **Fourth Affirmative Defense**

The '473 Patent is not unenforceable.

#### **Fifth Affirmative Defense**

Defendant's Counterclaims are barred, in whole or in part, by the doctrine of unclean hands.

**Sixth Affirmative Defense**

Defendant's Counterclaims are barred, in whole or in part, by the doctrine of estoppel.

**Seventh Affirmative Defense**

Defendant's Counterclaims are barred, in whole or in part, by the doctrine of laches.

**Eighth Affirmative Defense**

Defendant's Counterclaims are barred, in whole or in part, by the doctrine of waiver.

**Ninth Affirmative Defense**

Defendant's Counterclaims are barred, in whole or in part, by the doctrine of privilege.

**PRAYER FOR RELIEF**

WHEREFORE, having answered the allegations of Defendant's Counterclaims and asserted its affirmative defenses thereto, Convoke prays for the following relief:

- a. that Defendant's Counterclaims be dismissed, with prejudice, with costs taxed against Defendant;
- b. that Convoke be awarded its attorneys' fees incurred in defending against Defendant's Counterclaims;
- c. that Convoke be awarded the relief against Defendant prayed for in its Complaint; and
- d. that Convoke be granted such other and further relief against Defendant as the Court deems just and proper.

This 5th day of August, 2011.

Respectfully submitted,

*/s/ A. James Anderson*

---

Eric M. Albritton  
Texas State Bar No. 00790215  
ema@emafirm.com  
Stephen E. Edwards  
Texas Bar No. 00784008  
see@emafirm.com  
ALBRITTON LAW FIRM  
P.O. Box 2649  
Longview, Texas 75606  
Telephone: (903) 757-8449  
Facsimile: (903) 758-7397

T. John Ward, Jr.  
Texas Bar No. 00794818  
jw@wsfirm.com  
Wesley Hill  
Texas State Bar No. 24032294  
wh@wsfirm.com  
WARD & SMITH LAW FIRM  
P.O. Box 1231  
Longview, Texas 75606  
Telephone: (903) 757-6400  
Facsimile: (903) 757-2323

A. James Anderson  
Georgia Bar No. 016300  
ajanderson@rkmc.com  
Anna C. Halsey  
Georgia Bar No. 208034  
achalsey@rkmc.com  
Elizabeth V. Thomas  
Georgia Bar No. 624263  
evthomas@rkmc.com  
Ailis L. Burpee  
Georgia Bar No. 623492  
alburpee@rkmc.com  
Jennifer A. Adler  
Georgia Bar No. 217712  
jaadler@rkmc.com

Tara S.G. Sharp  
Georgia Bar No. 623320  
tgsharp@rkmc.com  
ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
One Atlantic Center  
1201 West Peachtree Street  
Atlanta, Georgia 30309  
Telephone: (404) 760-4300  
Facsimile: (404) 233-1267

Marla R. Butler  
Georgia Bar No. 099917  
mrbutler@rkmc.com  
Bryan J. Vogel  
New York Bar No. 3933736  
bjvogel@rkmc.com  
ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
601 Lexington Avenue, 34th Floor  
New York, New York 10022  
Telephone: (212) 980-7400  
Facsimile: (212) 980-7499

Trevor John Foster  
State Bar No. 0345568  
tjfoster@rkmc.com  
ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
2800 LasSalle Plaza, 800 LaSalle Avenue  
Minneapolis, Minnesota 55402  
Telephone: (612) 349-8500  
Facsimile: (612) 339-4181

Attorneys for Plaintiff CONVOLVE, INC.



**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who are deemed to have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(d) and (e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by email and/or fax, on this the 5th day of August 2011.

/s/ A. James Anderson

A. James Anderson